

REMARKS

At the time of the Final Office Action dated May 13, 2005, claims 1-22 and 25-39 were pending and rejected in this application. Independent claims 1, 6, 10, 25, 29, 32, and 36 have been amended to clarify that the embedded instructions codes include self-executing application code. Applicant submits that the present Amendment does not generate any new matter issue.

Applicant acknowledges, with appreciation, Examiner Simitoski's courtesy and professionalism in conducting a personal interview on October 26, 2005, during which the present Office Action was discussed, and in conducting a telephonic interview on November 9, during which the present Amendment was discussed. It is Applicant's understanding that the present Amendment would distinguish the claimed invention over the applied prior art.

CLAIMS 1-3, 6-13, 16-20, 29-30 AND 32-39 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY GINTER ET AL., U.S. PATENT NO. 5,892,900 (HEREINAFTER GINTER)

On pages 2-7 of the Office Action, the Examiner asserted that Ginter discloses the claimed invention. This rejection is respectfully traversed.

The independent claims have been amended to clarify that the embedded instructions include self-executing application code. These feature is neither taught nor suggested by the applied prior art. Applicant, therefore, respectfully submits that the imposed rejection of claims 1-

3, 6-13, 16-20, 29-30 and 32-39 under 35 U.S.C. § 102 for anticipation based upon Ginter is not factually viable and, hence, solicits withdrawal thereof.

**CLAIMS 10, 12, 15 AND 20-21 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING
ANTICIPATED BY STEFIK ET AL., U.S. PATENT NO. 6,236,971 (HEREINAFTER STEFIK)**

On pages 7-8 of the Office Action, the Examiner asserted that Stefik discloses a method corresponding to that claimed. This rejection is respectfully traversed.

Independent claim 10 recites, in part, "executing instruction codes embedded in said computer readable content." In the statement of the rejection, the Examiner asserted that the "usage rights" disclosed by Stefik are comparable to the claimed instruction codes. Applicant respectfully disagrees.

Referring to Fig. 7 and column 10, lines 4-6 of Stefik, the rights portion 104 (i.e., the usage rights) "will contain a data structure, such as a look-up table, wherein the various information with a right is maintained." One having ordinary skill in the art would have construed the term of "executing instruction codes" to arrive at the plain meaning that this term is directed to "instruction codes" that are executable (i.e., computer/program code). This feature is completely different than the data structure disclosed by Stefik. Thus, given the plain meaning of the term "executing instruction codes ...", one having ordinary skill in the art would not consider the rights portion 104 (i.e., usage rights) of Stefik to identically disclose this claimed feature.

Furthermore, independent claim 10 has been amended to clarify that the embedded instructions include self-executing application code. This feature is neither taught nor suggested by the applied prior art. Applicant, therefore, respectfully submits that the imposed rejection of claims 10, 12, 15, and 20-21 under 35 U.S.C. § 102 for anticipation based upon Stefik is not factually viable and, hence, solicit withdrawal thereof.

CLAIMS 4-5, 25-28 AND 31 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS

BASED UPON GINTER

On pages 8-11 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Ginter to arrive at the claimed invention. This rejection is respectfully traversed.

Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of the claims under 35 U.S.C. § 102 for anticipation based upon Ginter. Specifically, Ginter neither discloses nor suggests embedding instruction code, corresponding to that claimed, in a computer readable medium.

Furthermore, Applicant submits that the Examiner has not established a prima facie basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite

factual basis and lack of the requisite realistic motivation.¹ In particular, the Examiner has failed to make the requisite factual findings to support the Examiner's assertion that it is conventional to embed a self-executing applet in a computer readable content to enforce usage permissions of content.² Although the Examiner can take official notice of facts outside of the record, these facts must be of such a notorious character so as to be instantly and unquestionably recognized as "well-known" in the art. See M.P.E.P. § 2144.03. As also discussed in M.P.E.P. § 2144.03, Applicant has the right to challenge the Examiner's assertion as to the officially noticed facts. Upon such a traverse by Applicant, the Examiner is to cite a reference to support the Examiner's position.

In this regard, Applicant respectfully submits that embedding a self-executing applet in a computer readable content to enforce usage permissions of content is not of such a notorious character to warrant "official notice" by the Examiner. Thus, Applicant traverses the Examiner's assertion, and if the Examiner continues to maintain this assertion, Applicant requests that the Examiner provide a factual basis of record for the assertion.

¹ In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to identify a source in the applied prior art for: (1) claim limitations; and (2) the motivation to combine references or modify a reference in the reasonable expectation of achieving a particular benefit. Smiths Industries Medical System v. Vital Signs Inc., 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). In so doing, it is legally erroneous to ignore any claim limitation. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

² The Examiner required to make "clear and particular" factual findings as to any specific understanding or specific technological principle which would have realistically impelled one having ordinary skill in the art to modify the reference to arrive at the claimed invention. Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); Ecolochem Inc. v. Southern California Edison, Co., 222 F.2d 973, 56 USPQ2d 1065 (Fed. Cir. 2000); In re Kotzaab, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); In re Dembiczak, 175 F.2d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

For the reasons stated above, Applicant respectfully submits that the imposed rejection of claims 4-5, 25-28 and 31 under 35 U.S.C. § 103 for obviousness based upon Ginter is not viable and, hence, solicits withdrawal thereof.

CLAIMS 14-15 AND 22 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON STEFIK

On pages 11-12 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Stefik to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 14-15 and 22 dependent from independent claim 10, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 10 under 35 U.S.C. § 102 for anticipation based upon Stefik. Specifically, Stefik neither discloses nor suggests embedding instruction code, corresponding to that claimed, in a computer readable medium. Applicant, therefore, respectfully submits that the imposed rejection of claims 14-15 and 22 under 35 U.S.C. § 103 for obviousness based upon Stefik is not viable and, hence, solicits withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing

Reply Under 37 C.F.R. §1.116
Expedited Procedure - Group Art Unit :
Application No. 10/015,378
Filed: 12/12/2001
Attorney Docket No.: 7161-208U

remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 14, 2005

Respectfully submitted,



Scott D. Paul
Registration No. 42,984
Steven M. Greenberg
Registration No. 44,725
Christopher & Weisberg, P.A.
200 E. Las Olas Blvd., Suite 2040
Fort Lauderdale, FL 33301
Tel: (954) 828-1488
Facsimile: (954) 828-9122

43647